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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,166	12/04/2003	Indran Naick	AUS920030823US1	6763

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IBM Corporation
IP Law Department
11400 Burnet Road
Austin, TX 78758

EXAMINER

DESIR, PIERRE LOUIS

ART UNIT PAPER NUMBER

2681

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/728,166	Applicant(s) NAICK ET AL.	
	Examiner Pierre-Louis Desir	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant argues that Walters does not teach “sending one or more addresses to a global positioning system device from an address file storing a plurality of addresses in a computer.” Applicant also adds that the office action uses “navigation related data” synonymously with “addresses.” Applicant further discloses that Walters never defines navigation data or navigation related data as being “addresses” or “stored addresses.”

Examiner agrees with Applicant’s assertions that the office action uses “navigation related data” synonymously with “addresses.” To support this use, Examiner refers Applicant to col. 8, lines 22-27, wherein Walters defines “navigation related data” as routes, waypoints, points of interest, track logs, general cartographic, addresses and the like which can be wirelessly transmitted and received between handheld/portable devices.

The independent claims 1, 7, and 13 read, selecting one or more addresses from the address file, and transmitting the selected address to a global positioning device. Walters discloses in the “background of the invention” section that some PDAs are capable of transferring an address book from one PDA to another (see col. 2, lines 2-5). Walters further discloses a first handheld device including a memory from which navigation related data is being retrieved (i.e., navigation related data is being selected from the memory) (see fig. 6, col. 14, lines 17-22). Walters also discloses that the retrieved navigation related data is wirelessly transmitted to a second handheld device (see fig. 6, col. 14, lines 23-29).

Therefore, Walters, however broadly, reads on the claims as written.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-6, 11-12, and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5-6, 11-12, and 17-18 recite the limitation "the connector". There is insufficient antecedent basis for this limitation in the claim.

Note: for the process of examination, Examiner will interpret "the connector" as "the means," as related to claims 5-6 and 17-18, and claims 11-12 will be interpreted accordingly. Applicant is referred to the indicated claims for the interpretation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Walters et al. (Walters), U.S. Patent No. 6816782.

Regarding claim 1, Walters discloses a wireless communication system and method for sending one or more addresses to a global positioning system device from an address file storing a plurality of addresses in a computer (see abstract and col. 7, lines 55-61), comprising: means for selecting one or more stored addresses from the address file (see fig. 6, col. 6, lines 63-66, col. 8, lines 22-27, and col. 14, lines 17-29); means for transmitting said selected one or more addresses to a global positioning system device (i.e., the first and the second thin clients, are adapted to transmit and receive the navigation related data wirelessly between the first and the second thin clients, wherein at least one of the first and second thin clients includes GPS enabled handheld device) (see figs. 4-5, col. 9, lines 20-24, 39-41, and col. 14, lines 17-29); and means for populating the address fields in the global positioning system device with the transmitted address (i.e., the second thin client includes a handheld GPS enabled device, and is adapted to receive navigation related data from the first thin client and has software stored or housed in memory which is operable on the received navigation related data to perform a route calculation between two or more locations. Thus, for the second client to perform route calculation, it has to have received (mean for populating) various data for the computation) (see col. 9, lines 62-67).

Regarding claims 2, 8, and 14, Walters discloses a system and method (see claim 1 rejection) wherein the address file is a personal digital assistant address book (see col. 7, line 67, and col. 8, lines 22-27).

Regarding claims 3, 9, and 15, Walters discloses a system and method (see claim 1 rejection) wherein the address file is a cellular phone address book (see col. 7, line 67, and col. 8, lines 22-27).

Regarding claims 4, 10, and 16, Walters discloses a system and method (see claim 1

rejection) wherein address file is a laptop computer address book (see fig. 5B, col. 10, line 34).

Regarding claims 5, 11, and 17, Walters discloses a system and method (see claim 1 rejection) wherein the Bluetooth is used for transmitting the addresses to a global positioning system device (see col. 7, lines 57-62).

Regarding claims 6, 12, and 18, Walters discloses a system and method (see claim 1 rejection) wherein infrared is used for transmitting the addresses to a global positioning system device (see col. 7, lines 57-62).

Regarding claim 7, Walters discloses a wireless communication system and method (see abstract), which performs the steps as described in claim 1 rejection (see claim 1 rejection).

Regarding claim 13, Walters discloses in a wireless communication system, a computer program having code recorded on a computer readable medium for sending one or more addresses to a global positioning system device from an address file storing a plurality of addresses in a computer (see abstract and col. 7, lines 55-61, and refer to claim 1 rejection), comprising: means for selecting one or more stored addresses from the address file (see fig. 6, col. 6, lines 63-66, col. 8, lines 22-27, and col. 14, lines 17-29); means for transmitting said selected one or more addresses to a global positioning system device (i.e., the first and the second thin clients, are adapted to transmit and receive the navigation related data wirelessly between the first and the second thin clients, wherein at least one of the first and second thin clients includes GPS enabled handheld device) (see figs. 4-5, col. 9, lines 20-24, 39-41, and col. 14, lines 17-29); and means for populating the address fields in the global positioning system device with the transmitted address (i.e., the second thin client includes a handheld GPS enabled device, and is adapted to receive navigation related data from the first thin client and has

software stored or housed in memory which is operable on the received navigation related data to perform a route calculation between two or more locations. Thus, for the second client to perform route calculation, it has to have received (mean for populating) various data for the computation) (see col. 9, lines 62-67).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2681

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre-Louis Desir
AU 2681
01/11/2006



JOSEPH FEILD
SUPERVISORY PATENT EXAMINER